

REMARKS / ARGUMENTS

I. General Remarks and Disposition of the Claims.

Claims 1-44 are pending in this application. Claims 1-16 and 18-31 stand rejected. Claims 17 and 32 have been withdrawn from consideration. Claims 33-44 have been cancelled. Applicants respectfully request reconsideration in light of the remarks contained herein. Applicants reserve their right to take up prosecution on the claims as originally filed in this or an appropriate continuing application.

II. Remarks Regarding Species Election.

Claims 17 and 32 fall outside the elected species but are dependent on generic claims (1 and 18 respectively) and should be allowed if the corresponding generic claims are allowed. Applicants again request that these claims be held in abeyance pending resolution of the patentability of the corresponding generic claims. Applicants reserve the right to pursue additional species should a generic be allowed, or in a divisional or other continuing application.

III. Remarks Regarding Objections to the Drawings.

The Examiner has objected to the drawing because "suitable descriptive and concise legends should be provided to label the depicted elements of the invention such as the water concentration sensor 48 in Figs. 1 and 3 and the densimeter in Fig. 3 for understanding of the drawings (37 CFR 1.84(o))." (Office Action at 3.)

Applicants respectfully assert that a suitable description is provided in the Specification of the present application for both the water concentration sensor 48 (*See* ¶ [0021]) and the densometer 64 (*See* ¶ [0027]). Furthermore, Applicants respectfully note that the sensor is clearly depicted in Figs. 1 and 3 by the label 48, and the densometer is clearly depicted in Fig. 3 by the label 64. Accordingly, Applicants respectfully request the withdrawal of these

objections with regards to the Drawings. Alternatively, if Applicants have not addressed the Examiner's concerns, Applicants respectfully request the Examiner further clarify his objection.

IV. Remarks Regarding Rejections Under 35 U.S.C. § 102.

A. DE 1921681.

The Examiner has rejected claims 1-3 under 35 U.S.C. 102(b) as being anticipated by DE 1921681. (Office Action at 4.) With respect to this rejection the Examiner stated:

DE discloses a system for preparing a mixture of water and at least one non-aqueous material, comprising: a mixing zone 6; means 4, 8 for injecting water into the mixing zone; means for injecting the at least one non-aqueous material into the mixing zone (the conveyor means seen in the Figure); and a sensor 1 disposed within the mixing zone that measures the concentration of water in the mixture; wherein the mixing zone comprises a mixing tub 6; wherein the sensor 1 is disposed within the mixing tub as seen in the Figure.

(Office Action at 4-5.) Applicants respectfully traverse. Applicants cannot adequately review DE 1921681 to determine if it does indeed anticipate the present claims, as this patent is not in English. The Examiner relies on the Figure and the Specification of DE 1921681 in making his rejections. The MANUAL OF PATENT EXAMINING PROCEDURE (2004) (hereinafter "MPEP") notes that if the underlying document of prior art is relied upon when making a rejection, a translated document must be provided by the Examiner. Specifically, the MPEP states the following:

To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. *If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained* so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will

include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection.

MPEP § 706.02(II) (emphasis added). Accordingly, Applicants respectfully request a translation (in English) of DE 1921681 so that Applicants can adequately analyze the elements of the Figure used in the Examiner's rejections in making an appropriate response.

B. Alekhin.

The Examiner has rejected claims 1-4 and 16 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,370,885 to Alekhin, *et al.* (hereinafter "Alekhin"). (Office Action at 5.) With respect to this rejection the Examiner stated:

Alekhin et al. discloses a system for preparing a mixture of water and at least one non-aqueous material, comprising: a mixing zone 2; means 1 (or the conduit(s) attached thereto) for injecting water into the mixing zone; inherent not-shown means for injecting the at least one non-aqueous material into the mixing zone; and a sensor 3 disposed within the mixing zone that measures the concentration of water in the mixture; wherein the mixing zone comprises a mixing tub 2; wherein the sensor 3 is disposed within the mixing tub as seen in Figure 1; a recirculation circuit as seen in Figure 1 with a centrifugal pump 1 in the circuit.

(Office Action at 5.) Applicants respectfully traverse because Alekhin does not disclose each and every element recited in the subject claims as required to anticipate the claims under 35 U.S.C. § 102(b). MPEP § 2131. In particular, Applicants respectfully submit that Alekhin has not been shown to teach or suggest a "means for injecting water into the mixing zone," a "means for injecting the at least one non-aqueous material into the mixing zone," or "a sensor disposed within the mixing zone that measures the concentration of water in the mixture," as recited by Applicants' independent claim 1.

With respect to a "means for injecting water into the mixing zone," the Examiner points to disperser 1 of Alekhin. (Office Action at 5.) However, the disperser 1 of Alekhin is

directed to converting solids to a colloidal state. (Alekhin, 3:62-64). In the disperser 1 of Alekhin, “solids are broken up through cavitation phenomena in a pulsing stream of liquid passing through the stator notches which are shut off at regular intervals of time by the rotor projections.” Nowhere does Alekhin state that disperser 1 is a “means for injecting *water* into the mixing zone” as recited by Applicants’ claim 1, and therefore does not teach each and every element of independent claim 1.

With respect to a “means for injecting the at least one non-aqueous material into the mixing zone,” the Examiner states that Alekhin comprises an “inherent not-shown means for injecting the at least one non-aqueous material into the mixing zone.” (Office Action at 5.) The Examiner’s assertion that Alekhin discloses an “inherent not-shown means for injecting the at least one non-aqueous material into the mixing zone” lacks the requisite evidentiary support. The Examiner has not cited any portion of Alekhin as disclosing that a means for injecting the at least one non-aqueous material into the mixing zone exists. However, as the MPEP notes:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. *The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*’”

MPEP § 2112.IV. (emphasis added). Accordingly, the Examiner is required to provide extrinsic evidence to support a contention that Alekhin comprises a “means for injecting the at least one non-aqueous material into the mixing zone.” Applicants respectfully submit that the Examiner has not provided the requisite extrinsic evidence to support the Examiner’s assertion. That the Examiner must provide such evidence is reiterated in Section 2144.03.B of the MPEP, stating that “the Board cannot simply reach conclusions based on its own understanding or experience--

or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” Accordingly, because the Examiner has not provided concrete evidence to disclose or suggest the limitation of a “means for injecting the at least one non-aqueous material into the mixing zone,” Applicants respectfully submit that independent claim 1 and the claims dependent therefrom, have not been shown to be anticipated by Alekhin.

With respect to “a sensor disposed within the mixing zone that measures the concentration of water in the mixture,” the Examiner points to the sensor 3 of Alekhin. (Office Action at 5.) However, the sensor 3 of Alekhin is actually a pickup, which measures electrical conductivity. (Alekhin, 4:13-15). Nowhere does Alekhin disclose that the sensor 3 measures the *concentration of water* in the mixture as recited by Applicants’ claim 1, and therefore does not teach each and every element of independent claim 1.

Applicants respectfully submit that independent claim 1 and the claims dependent therefrom, have not been shown to be anticipated by Alekhin. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1-4 and 16.

V. Remarks Regarding Rejections Under 35 U.S.C. § 103.

The Examiner has rejected claims 1, 2, 4-16, and 18-31 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,114,239 to Allen (hereinafter “Allen”) in view of Japan 3-10662. (Office Action at 6.) Applicants respectfully traverse because the Examiner has not established a *prima facie* case of obviousness, in that the cited references do not disclose, expressly or inherently, each and every claim limitation and there is no suggestion or motivation to combine the references with a reasonable expectation of success. *See* MPEP § 2142.

First, the cited references do not teach each and every claim limitation. *See* MPEP § 2142. In particular, independent claims 1 and 18 recite a sensor “that measures the *concentration of water* in the mixture.” The Examiner relies upon JP 3-10662 for the teaching of the water-concentration sensor. Specifically, the Examiner states that “Allen . . . does not disclose the sensors being water concentration sensors. JP 3-10662 discloses . . . a water concentration sensor 30 therein.” (Office Action at 24.) Applicants respectfully disagree. As far as Applicants can ascertain from the abstract, rather than disclosing a sensor that measures the concentration of the *water* in the mixture, JP 3-10662 is directed to a sensor 30 that measures the concentration of the liquid (e.g. concentration of cut laver sheet within the liquid). Nowhere in the abstract does JP 3-10662 indicate that the sensor measures the concentration of *water* in the liquid. Accordingly, JP 3-10662 does not teach or suggest a concentration sensor that measures the concentration of *water* in the mixture. Nor can Allen be used to supply this missing recitation. Accordingly, Allen in view of JP 3-10662 does not teach or suggest each and every limitation of independent claims 1 and 18.

Second, there is no suggestion or motivation to combine the references with a reasonable expectation of success. *See* MPEP § 2142. “Obviousness can only be established by . . . modifying the teaching of the prior art where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP § 2143.01. Applicants respectfully submit that the Examiner has not pointed to any suggestion or motivation to combine the teachings of JP 3-10662 and Allen that is present in the cited references themselves. The Examiner has provided no evidence or finding of the specific understanding or principle

within the knowledge of a person of ordinary skill in the art at the time of the invention that would have supplied the motivation to combine the cited references. *See* MPEP § 2143.01.

Therefore, independent claims 1 and 18 are not obviated by Allen in view of JP 3-10662. The remaining rejected claims depend either directly or indirectly on independent claims 1 and 18. All these dependent claims, which include all the limitations of their corresponding independent claim, are allowable for at least the reasons cited above with respect to independent claims 1 and 18. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1, 2, 4-16, and 18-31.

Furthermore, the MPEP states:

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.

MPEP § 706.02(II). Therefore, if the Examiner wishes to carry forth his rejections in the next office action, Applicants respectfully request a translation (in English) of the supporting document of JP 3-10662 to better assess the exact type of sensor used in the system, as the abstract seems to indicate that the sensor 30 only measures the concentration of the liquid and not the concentration of the *water* in the liquid.

VI. No Waiver.

All of Applicants' arguments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

SUMMARY

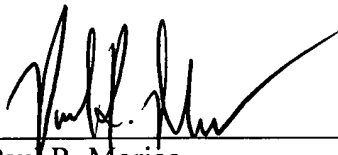
In light of the above remarks and arguments, Applicants respectfully submit that the application is now in condition for allowance and earnestly solicit early notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile or electronic mail, as indicated below.

Applicants believe that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for any extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition therefore, and direct that any fees be debited from Baker Botts L.L.P., Deposit Account No. 02-0383, Order Number 063718.0399.

Respectfully submitted,

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